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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/556,931	11/16/2005	Jose Manuel Bartolome-Nebreda	PRD2059USPCT	5571
45511 7590 06/18/2008 WOODCOCK WASHBURN LLP CIRA CENTRE, 12TH FLOOR 2929 ARCH STREET PHILADELPHIA, PA 19104-2891				
EXAMINER				
MABRY, JOHN				
ART UNIT		PAPER NUMBER		
1625				
NOTIFICATION DATE		DELIVERY MODE		
06/18/2008		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patents@woodcock.com

# Office Action Summary

**Application No.**

10/556,931

**Applicant(s)**

BARTOLOME-NEBRED A ET AL.

**Examiner**

John Mabry, PhD

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 February 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 3-6 and 8 is/are pending in the application.
- 4a) Of the above claim(s) 9-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3-6 and 8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

***Examiner's Response***

Applicant's response on October 22, 2007 filed in response to the Election/Restriction dated September 21, 2007 has been received and duly noted. The Examiner acknowledges Applicant's proposed restriction. In the Non-Final Office Action, the Examiner accepted this proposed restriction but only accepted and examined the compound and composition claims.

Thus, the restriction requirement is deemed proper and **FINAL**.

Applicant's response on February 25, 2008 filed in response to the Office Action dated December 4, 2008 has been received and duly noted.

In view of this response, the status of the rejections/objections of record is as follows:

Applicant is respectfully reminded that it is **required** that all claims be amended to elected group. Examiner also warns Applicant not to introduce new matter when amending.

***Status of the Claims***

Claims 1, 3-6 and 8 are pending and rejected.

Claims 2 and 7 have been cancelled.

Claims 9-19 are directed towards non-elected subject matter.

***35 USC § 112 Rejection(s)***

The 112-1<sup>st</sup> rejection of claims 1-9 regarding the scope of enablement for "R1 – R6 and R8", Y, X, the full scope of the terms alkyl, alkenyl, aryl and heteroaryl have **not**

been overcome in view of Applicants amending the claims. Said terms have not been fully amended to overcome rejection.

The 112-1<sup>st</sup> rejection of claims 1-9 regarding the terms "radical" have not been overcome in view of Applicant's argument – this term remains present in the claims.

As stated in previous Non-Final Office Action, the term "radical" is an atom or group of atoms with an unpaired electron. This is the acceptable mean of this term throughout the scientific community, especially in the field of chemistry.

Applicant has argued that Examiner Desai, whom is affiliated with this case, has allowed cases wherein the term "radical" is used to define a Markush group. Examiner Mabry would like to clearly state that each individual examiner is responsible for each individual case by themselves, regardless of what another examiner has done (In re Giolito and Hofmann, 188 USPQ 645 (C.C.P.A. 1976)). Furthermore, in patent US 7,314,935, the term "radical" is specifically defined in the Specification in column 4 and 5. In the instant application, there is no such definition.

### **35 USC § 102(a) Rejection(s)**

Applicant's proviso with respect to:

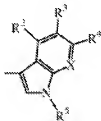
the proviso that compounds wherein simultaneously  $-a^1-a^2-a^3-a^4-$  is (a-4),  $-Z^1-----Z^2-$  is (b-2) and Y is (c-2) are excluded,

has been fully considered. The 102(a) rejection of Tran ('911) has been withdrawn.

**35 USC § 103(a) Rejection(s)**

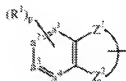
Applicant's arguments with respect to 103(a) rejections have been fully considered and are not persuasive.

Applicant has argued that '911 only describes a pyridinyl group. Examiner is not certain what chemical structure Applicant is describing:



the pyridinyl of the

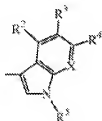
subgenus OR



the pyridinyl of the

subgenus.

Since the Applicant is discussing X=CR6 in the argument, the Examiner will



address the

subgenus argument first. Tran teaches X can be CR6 or N

(see page 2, line 21 and Formula I). Thus, Applicant's claims are rendered obvious over Tran.

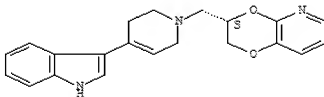
Secondly, the Applicant's argument is not persuasive and has not overcome 103(a) positional isomer rejection made in Non-Final Office Action. Tran teaches and

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discloses compounds and pharmaceutical compositions of the same genus of Formula I for the inhibition of serotonin reuptake (SSRI) and treatment and prevention of neurological and related disorders (see entire disclosure).

Additionally, Applicant claims compounds of Formula I wherein  $-Z^1-Z^2-$  =  $-O-CH_2-CH_2-O-$ , ( $R^1$ )=H,  $p=0$ ,  $Y=(c-2)$  wherein  $m=0$ ,  $R^5=H$ ,  $X=C$  and  $R^2$ ,  $R^3$ ,  $R^4=H$ .

Tran discloses compounds and pharmaceutical compositions of Formula I, wherein  $-Z^1-Z^2-$  =  $-O-CH_2-O-$ , ( $R^1$ )=H,  $p=0$ ,  $Y=(c-2)$  wherein  $m=0$ ,  $R^5=H$ ,  $X=C$  and  $R^2$ ,  $R^3$ ,  $R^4=H$  (see Example 1, page 15).



Tran differs from the instant application at the  $-Z^1-Z^2-$  position: Tran's  $-O-CH_2-CH_2-O-$  versus Applicant's  $-O-CH_2-O-$ . This are considered ring homologs.

The MPEP 2144.09 which states: Compounds which are homologs (compounds differing regularly by the successive addition of the same chemical group, e.g., by  $-CH_2-$  groups) are generally of sufficiently close structural similarity that there is a presumed expectation that such compounds possess similar properties. *In re Wilder*, 563 F.2d 457, 195 USPQ 426 (CCPA 1977).

***Conclusion***

Claims 1, 3-6 and 8 are pending and rejected.

Claims 2 and 7 have been cancelled.

Claims 9-19 are directed towards non-elected subject matter.

Applicant is respectfully reminded that it is required that all claims be amended to elected group. Examiner also warns Applicant not to introduce new matter when amending.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

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Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Mabry, PhD whose telephone number is (571) 270-1967. The examiner can normally be reached on M-F from 9am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Andres, PhD, can be reached on (571) 272-0867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

/John Mabry/  
Examiner  
Art Unit 1625

/Rita J. Desai/  
Primary Examiner, Art Unit 1625